

Under the applicable standard, an application “shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.” (PCT Rule 13.1). Unity of invention is fulfilled “when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression ‘special technical feature’ shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” (Emphasis added, PCT Rule 13.2).

The Examiner argues that the inventions of Group I-V lack the same or corresponding special technical feature because the claimed invention encompasses different methods of reducing NADPH activity in a plant to enhance pathogen resistance using different products. Applicants respectfully disagree.

First, Groups I-V all relate to a single inventive concept. As stated in the specification and repeated in the claims, the general inventive concept of the present application relates to generating or increasing resistance to pathogens in plants by reducing the quantity, activity or function of an NADPH oxidase in a plant or a tissue, organ, part or cell thereof. Therefore, all of the claims share the same or corresponding technical feature of reducing the quantity, activity or function of an NADPH oxidase. Similarly, all of the polypeptide sequences shown in SEQ ID NOs: 2, 4, 6, 8, 10, 12, 14, 16, 18, 20 and 22 are NADPH oxidases (see specification at pages 59-61). Moreover, because all the claims share the same or corresponding technical feature, the same art and field of search relevant to the provisionally elected Group I would also be relevant to all the other Groups. Different searches would not be required. Accordingly, Applicants respectfully request that the Examiner reconsider the restriction requirement.

Second, the Examiner has failed to cite any reference to rebut the novelty of the present invention. Moreover, as stated in the International Preliminary Examination Report (IPER), “On the basis of the cited literature, a person skilled in the art would expect increased resistance to be achievable by increasing the NADPH oxidase” (emphasis added). Therefore, a method for increasing resistance by reducing NADPH oxidase (as recited in claims 1-10 of the international application) was found to be novel and involve an inventive step. The Patent Office has thus not established the presence of Applicants’ technical feature in the prior art as is required for a finding of lack of unity.

The Examiner further alleges that the Applicant is only entitled to the first method of reducing NADPH activity/content/function in a plant by sense/antisense/dsRNA (Group I) and the polynucleotide encoding SEQ ID NO: 2, citing to 37 CFR § 1.475 (d) which refers to 37 CFR § 1.476 (c). Applicants respectfully disagree. 37 CFR § 1.476 (c) provides that “In the case of non-compliance with unity of invention and where no additional fees are paid, the international search will be performed on the invention first mentioned (“main invention”) in the claims.” (Emphasis added). The Examiner must first find a lack of unity before invoking the provision of 37 CFR § 1.476 (c) and 37 CFR § 1.475 (d) which defines the “main invention” recited in 37 CFR § 1.476 (c). Since the claims of the present invention all share the special technical feature of reducing NADPH oxidase as explained above, since the Examiner cannot base the lack of unity on dependent claims, and because no art was cited to defeat novelty, the Examiner has not established a lack of unity under the applicable standard. Moreover, if no lack of unity is found with respect to the independent claims, it does not matter whether dependent claims contain further inventions. See Chapter 10 §10.07, PCT International Search and Preliminary Examination Guidelines. Accordingly, 37 CFR § 1.476 (c) and 37 CFR § 1.475 (d) do not apply. Furthermore, since the International Searching Authority and the International Examination Authority found no lack of unity of invention, the search should not be restricted to the invention first mentioned for this additional reason.

As just mentioned, unity of invention was found during the International stage. As shown in the International Search Report and the International Preliminary Examination Report, the claims were searched and examined together. As described in MPEP § 1850 subsection I, the unity of invention standard applicable to the International stage is equally applicable during the national stage. Furthermore in MPEP § 1850 subsection II, “the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Searching Authority.” The International Searching Authority and the International Examination Authority applying the correct standard for unity of invention under PCT Rules 13.1 and 13.2 found that unity exists. Since the search has already been conducted by the International Search Authority and the International Examination Authority and no lack of unity of invention has been found, and because the search of the provisionally elected Group I would be commensurate in scope with the other Groups since the same technical feature is shared by all the Groups, there

would be no undue burden on the Examiner to examine all Groups in one application. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement and examine all Groups in one application for this additional reason.

Moreover, PCT Article 27 entitled "National Requirements," provides in part "(1) No national law shall require compliance with requirements relating to form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations." Thus under PCT Article 27(1), the issue of lack of unity of invention should not be raised in the national phase of a PCT application when the issue was not raised during the PCT phase. Because there was no lack of unity rejection during the international phase by the International Searching Authority or the International Examination Authority, such a restriction is unjustified in the national phase of the present application.

CONCLUSION

For at least the above reasons, Applicants respectfully request that the restriction requirement be reconsidered and withdrawn.

Applicants respectfully reserve all rights to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR § 1.141 upon the allowance of a generic claim.

This response is filed within the one-month period for response from the mailing of the Office Communication, to and including June 29, 2008, pursuant to 37 CFR § 1.7(a). No further fee is believed due. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00067-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 

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